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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,044	06/26/2001	Dale F. McIntyre	83011F-P	1735

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EXAMINER

COULTER, KENNETH R

ART UNIT PAPER NUMBER

2141

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,044	MCINTYRE ET AL.	
	Examiner	Art Unit	
	Kenneth R Coulter	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/16/01</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Applicant is advised that should claim 5 be found allowable, claim 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP 706.03(k).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 17 of copending Application No. 09/892,042. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because both Applications teach the following:

1. A system for managing digital images, comprising: a server for allowing controlled access to a user image storage device having at least one digital image file of an image, said server having a communication system capable of communicating with a plurality of user computers, at least one of said user computers having said at least one digital image file, a software program for controlling access to said at least one digital image file, said software program for permitting automatic access to said at least one digital image file on said user computer by a third party and monitoring access by said third party without any further authorization by said user.
2. A system according to claim 1 wherein said at least one digital image file includes an electronic address for identifying that image came from said user.
3. A system according to claim 1 wherein said third party pays an access fee for use and/or down loading of said image from said user image file.
4. A system according to claim 3 wherein said service provider assigns a first predetermined credit to the account of the user of said downloaded image, a debit to the account of the third party downloading the image, and a second predetermined credit to the service provider.
5. A system according to claim 1 wherein a report is provided to said user regarding access to said digital media file.
6. A computer software product for managing digital images stored on a user computer, said software product comprising a computer readable storage medium having a

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computer program which when loaded into said user computer causes the computer to perform the following steps of: allowing controlled access by a service provider to said digital image files stored on said user computer, said provider having a communication system capable of communicating with a plurality of different devices, said software program using an electronic data file for permitting automatic access to said at least one digital image file by a third party and monitoring access by said third party without any further authorization by said user.

7. A method for monitoring access to digital image files on a user computer by third parties over a communication network by service provider, comprising the steps of: allowing controlled access by third parties to said digital image files on said user computer; monitoring access by said third parties to said digital image files; reporting said access by said third parties to said user.

8. The method according to claim 7 wherein said third party pays an access fee for use and/or down loading of said digital image file from said user.

9. A system according to claim 8 wherein said service provider assigns a first predetermined credit to the account of the user of said downloaded image, a debit to the account of the third downloading the image, and a second predetermined credit to the service provider.

10. A system according to claim 1 wherein a report is provided to said user regarding access to said digital media file.

11. A system for managing digital images, comprising: a server for allowing controlled access to a user image storage device having at least one digital image file of an image,

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said server having a communication system capable of communicating with a plurality of user computers, at least one of said user computers having said at least one digital image file, a software program for controlling access to said at least one digital image file, said software program for permitting automatic access to said at least one digital image file by a third party and monitoring access by said third party without any further authorization by said user.

12. A system according to claim 11 wherein said digital image file is stored on a service provider computer and is accessed by said third party on said computer.

13. A system according to claim 11 wherein said at least one digital image file includes an electronic address for identifying that image came from said user.

14. A system according to claim 11 wherein said third party pays an access fee for use and/or down loading of said image from said user image file.

15. A system according to claim 11 wherein said service provider assigns a first predetermined credit to the account of the user, a debit to the account of the third party downloading the image, and a second predetermined credit to the service provider.

16. A system according to claim 11 wherein a report is provided to said user regarding access to said digital media file.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Needham et al. (U.S. Pub. No. 2002/0188735) (Partially Replicated, Locally Searched Peer to Peer File Sharing System).

6.1 Regarding claim 1, Needham discloses a system for managing digital images, comprising:

a server for allowing controlled access to a user image storage device having at least one digital image file of an image, said server having a communication system capable of communicating with a plurality of user computers, at least one of said user computers having said at least one digital image file, a software program for controlling access to said at least one digital image file, said software program for permitting automatic access to said at least one digital image file on said user computer by a third party and monitoring access by said third party without any further authorization by said user (Abstract; p. 2, paragraph 14 "each PC stores the owner's collection of personally created digital **photographs** ..."; p. 1, paragraph 11 "The **index information may be**

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selectively propagated through a public network such as the Internet only between nodes operated by people having social connections ... This in effect creates a **private** peer to peer network within a larger public network ...”).

6.2 Per claim 2, Needham teaches a system according to claim 1 wherein said at least one digital image file includes an electronic address for identifying that image came from said user (p. 1, paragraph 11; p. 2, paragraph 16 “**globally unique** and very hard to guess **identifier**”; p. 2, paragraph 18 “index information”).

6.3 Regarding claim 3, Needham does not explicitly disclose a system according to claim 1 wherein said third party pays an access fee for use and/or down loading of said image from said user image file.

However, some sort of access fee to use a specific Internet service is inherent in the prior art.

6.4 Per claim 4, Needham teaches a system according to claim 3 wherein said service provider assigns a first predetermined credit to the account of the user of said downloaded image, a debit to the account of the third party downloading the image, and a second predetermined credit to the service provider (see the rejection of claim 3 above (paragraph 6.3)).

6.5 Regarding claims 5 and 10, Needham discloses a system according to claim 1

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wherein a report is provided to said user regarding access to said digital media file (p. 2, paragraph 18 "index information").

6.6 Per claims 6 – 9 and 11 – 16, the rejection of claims 1 – 5 and 10 under 35 USC 102(e) (paragraphs 6.1 – 6.5 above) applies fully.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER
PRIMARY EXAMINER

